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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,706

01/08/2007

Saskia Lehmann

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FACTOR & LAKE, LTD
1327 W. WASHINGTON BLVD.
SUITE 5G/H
CHICAGO, IL 60607

EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,706	Applicant(s) LEHMANN ET AL.	
	Examiner ROBERT SELLERS	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8 January 2007</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-11, drawn to a glass printing ink or lacquer comprising a bisphenol A epoxy resin, a UV hardening monomer, an amino, hydroxy, epoxy, acid, anhydride or acrylate-functional resin, and a photoinitiator.

Group II, claims 12-14, drawn to a method of using the glass printing ink or lacquer comprising pretreating a glass or superficially vitreous substrate, mixing a coupling agent into the ink or lacquer, and UV hardening it without a subsequent heat treatment (claim 14).

Group III, claims 12, 13 and 15, drawn to a method of using the glass printing ink or lacquer comprising printing a glass or vitreous substrate with the ink or lacquer without a coupling agent and UV hardening it.

Group IV, claims 12, 13 and 16, drawn to a method of using the glass printing ink or lacquer comprising printing a glass or vitreous substrate with the ink or lacquer without a coupling agent, UV hardening and thermally post-treating it.

2. The inventions listed as Groups I to IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature.

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The special technical feature is the combination of bisphenol A epoxy resin and an amino, hydroxyl, epoxy, acid, anhydride or acrylate-functional resin.

3. European Patent No. 1,086,403 (page 4, paragraph 24) discloses a stereolithographic or coating composition (page 14, lines 13-15) comprising a cationically curable liquid or solid compound including an epoxy resin (page 4, lines 33-34) such as particularly preferably a diglycidyl ether of bisphenol A (page 5, lines 2-3), a photoinitiator, a free radically curable component such as a liquid poly(meth)acrylate (page 8, paragraph 59) within the claimed UV hardening monomer according to page 5, lines 1-15 of the instant specification, and an epoxy-based cationic reactive modifier (page 12, paragraph 82) within the claimed epoxy-functional resin.
4. Steinmann et al. Patent No. 5,476,748 (col. 1, line 63 to col. 2, line 14) sets forth a mixture for producing relief images on printing plates (col. 11, lines 25-29) containing A) a liquid epoxy resin such as polyglycidyl ethers of a phenolic hydroxyl groups-containing compound (col. 3, lines 4-8), B) a cationic photoinitiator, C) a liquid diacrylate within the claimed UV hardening monomer, D) a liquid poly(meth)acrylate within the claimed acrylate-functional resin, E) a radical photoinitiator and F) an OH-terminated polyether, polyester or polyurethane within the claimed hydroxy-functional resin.
5. The special technical feature does not make a contribution over the prior art, thereby validating a holding of lack of unity.

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6. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

a) The UV hardening monomers such as the 1,6-hexanediol diacrylate of claim 7 used in Example 1 as shown in the table on page 17 of the specification.

b) The amino, hydroxy, epoxy, acid, anhydride or acrylate-functional resins such as melamine acrylate Nanocryl XP 21/0793 of Example 1.

c) The photoinitiators such as Darocur 1173/1173C wherein the chemical name and/or structure is revealed.

d) The ink or lacquer with or without the stabilizer of claim 9 wherein a species is indicated if present.

e) The ink or lacquer with or without the co-initiator of claim 10 wherein a species is designated if present.

7. Applicant is required, in reply to this action, to elect a single species ***within each of items a), b), c), d) and e)*** to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added.

An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Claims 1-16 are generic.

8. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical feature for the reasons espoused with respect to the holding of lack of unity hereinabove.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. German Patent No. 2,343,589 designated as a X reference in the International Search Report filed January 8, 2007 is directed to either a two-part ink composed of an epoxy resin and polyaminoamide, or a one-part ink of a modified polyester (Derwent abstract). The claimed bisphenol A epoxy resin and photoinitiator are not recited.

(571) 272-1093 (Fax No. (571)-273-8300)
Monday to Friday, 9:30 to 6:00

/Robert Sellers/
Primary Examiner
Division 1796

rs
5/27/2009